



Xerox Docket No. D/99620

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

On Appeal From Group Art Unit: 2176

Michelle Q. Wang BALDONADO et al.

Application No.: 09/461,040

Examiner: M. NGUYEN

Filed: December 15, 1999

Docket No.: 104323

For: SYSTEMS AND METHODS FOR ANNOTATING OBJECTS WHEN THE
ANNOTATION DEVICE DIFFERS FROM THE VIEWING DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the May 18, 2005 Final Rejection in this application. The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of \$130.00 in payment of the petition fee set forth in 37 CFR §41.20(a).

The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No. 24-0037. Two duplicate copies of this request are enclosed.

No Amendments are being filed at this time. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Gerhard W. Thielman
Registration No. 43,186

JAO:GWT/gwt

Date: August 18, 2005

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REMARKS

Claims 1-37 are pending in this application and stand finally rejected. The May 18, 2005 Final Office Action rejects claims 1-37 (maintained from the December 3, 2004 Office Action) under 35 U.S.C. §103(a) over U.S. Patent No. 6,173,287 to Eberman et al. (“Eberman”) in view of “Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations”, by Schilit et al., *CHI-98*, April 1998 (“Schilit”).

Applicants respectfully submit that the legal and factual basis of the prior art rejection contains “a clear error in fact or other deficiency” as specified in the July 12, 2005 *Official Gazette* Notices. In particular, the Final Office Action asserts, in paragraphs 3(c) at page 4, that “Schilit discloses a viewing device that is distinct from the annotation device” after acknowledging that Eberman fails to disclose these features.

As explained for reasons presented in the June 14, 2005 Request for Reconsideration at page 4, Applicants respectfully disagree that Schilit remedies the admitted deficiencies of Eberman. In particular, Schilit explicitly teaches that the display and annotation of the document are performed concurrently on the tablet, as shown in Fig. 1 that is referenced in the Final Office Action. Thus, the factual grounds for the Final Office Action assertion that Schilit teaches distinct devices for these functions is clearly erroneous.

Applicants’ independent claims are directed to an annotation system that associates annotations with at least one object, the annotation system comprising, *inter alia*, an annotation device allowing a user to make at least annotation independently from the object, and a viewing device for viewing the object, the viewing device being distinct from an annotation device, as recited in claim 1, and similarly recited for a method in claim 14 and an information storage media in claim 26. The annotation device includes an input device that inputs the annotation, an annotation linking circuit that establishes a link associating the annotation with at least one portion of the object; a database that stores the object identifier, the annotation and the link; and a synchronize circuit that associates the annotation with the

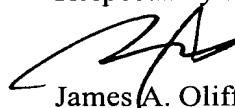
portion of the object based on the link and the object identifier.

The Final Office Action at page 8 characterizes Schilit as disclosing that “the annotation device is a portable personal digital assistant,” although page 252 of Schilit refers only to tablet displays and portable pen computers. Fig. 1 of Schilit clearly shows the pen tablet display operating as a viewing device and simultaneously as an annotation device. The Final Office Action at page 4 and June 29, 2005 Advisory Action at page 2 both assert that Schilit teaches “a viewing device that is distinct from the annotation device.” Applicants submit that Schilit directly contradicts this assertion.

Schilit discloses an “active reading machine” based on XLibris. In particular, Schilit teaches a tablet computer that combines a flat-panel display to image the document to be annotated and a “digital ink” stylus with which to make annotation marks directly on the tablet that displays the document using XLibris software. The stylus serves as a “pen” by simulating ink strokes while capable of “dwell” menu selection from pressing the pen at a stationary position. See pages 249 (Abstract), 252, 255 and Figs. 1 and 2 of Schilit.

Because the Final Office Action is factually deficient in asserting that Schilit teaches the viewing and annotation devices being distinct, Applicants respectfully assert that the prior art rejection represents clear error and should be reversed.

Respectfully submitted,



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